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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,523	07/25/2003	Baychar	BAY-410-04	1131

24956 7590 03/03/2006

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EXAMINER

MATZEK, MATTHEW D

ART UNIT PAPER NUMBER

1771

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,523	Applicant(s) BAYCHAR,	
	Examiner Matthew D. Matzek	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/23/06, 10/13/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 9/9/05, 2/10/05</u> |

Response to Amendment

1. The amendment dated 1/23/2006 has been fully considered and entered into the Record. Claims 9-20 remain active. Claim 21 has been canceled. The amended claims contain no new matter. The rejection of claims 9-20 under 112 2nd paragraph has been withdrawn due to amendment. The double patenting rejections have been withdrawn per the Terminal Disclaimers filed with this Application on 1/23/2006. The use of the Harada et al. (US 4,894,932) reference in the Office Action dated 9/21/2005 was due to a typographical error. No teachings from said reference have been relied upon and as such mention of Harada et al. has been eliminated in the rejection within this Office Action. The basis of the rejection of claims 9-20 remains consistent from the Office Action dated 9/21/2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin et al. (US 5,637,389) in view Ogden (US 5,727,336) as substantially set forth in the Office Action dated 9/21/2005.

Response to Arguments

3. Applicant's arguments filed 1/23/2006 have been fully considered but they are not persuasive.

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4. Applicant argues that while Colvin et al. disclose that the foam may be closed cell or open cell, one of ordinary skill in the art would not conclude that Colvin et al. intend to disclose a moisture transferring foam. Examiner agrees that the emphasis of foam of the Colvin et al. invention is not directed to its moisture transferring capability. However, an open-celled foam is capable of acting as a sponge, soaking up liquid by capillary action as evidenced in the last paragraph on page 362 of *Principles of Polymer Systems*, which has been provided by Applicant. Therefore if the foam is capable of transferring liquid it would certainly follow that the foam is capable of “breathing” and transferring moisture vapor as instantly claimed.

5. Applicant argues that Ogden does not disclose breathable, moisture transferring foam and moisture transferring nonwoven material. Ogden has only been relied upon for the teaching of the nonwoven and inner moisture transfer material. The properties of the breathable foam have been addressed supra. The apertured fabric of Ogden serves as the inner moisture transfer material. The second fabric layer of Ogden is a nonwoven and is sandwiched between the apertured top layer and the foam layer. As the nonwoven layer is made up of moisture-wicking (adsorbent) fibers (col. 3, lines 56-67) the nonwoven is necessarily breathable if it is capable of wicking moisture. Furthermore, the nonwoven of Ogden may comprise polyester and cellulosic fibers (col. 5, lines 33-51), which are the same materials used by Applicant to create the instantly claimed nonwoven layer on page 8 of the Specification.

6. Applicant argues that Examiner has failed to provide motivation to combine the Colvin et al. and Ogden references. One of ordinary skill at the time the invention was made would have found it obvious combine the two inventions of Colvin et al. and Ogden. The skilled artisan would have been motivated by the desire to create an shoe insole that reduces friction between

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the sock and footwear, thereby providing the shoe dimensional stability and durability (col. 3, lines 49-67).

7. Applicant argues that following the combination of the Colvin et al. and Ogden references one of ordinary skill would not have arrived at a “non-woven material having reversible enhanced thermal properties”. As stated on page 5 of the Office Action dated 9/21/2005 it is the position of the Examiner that since the combination of Colvin et al./Ogden and Harada is structurally identical, then it must also exhibit the resultant properties desired by Applicant of reversible enhanced thermal properties.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm

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Ms. Arti R. Singh
Primary Examiner
Tech Center 1700